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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,410	06/16/2000	Hu Yang	2039.007400	1569

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EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,410

Applicant(s)

YANG ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-10-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-23, 26-44, 46-51, 54-62 and 65-78 is/are pending in the application.
- 4a) Of the above claim(s) 4, 8, 23, 27, 51 and 73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 9-22, 26, 28-44, 46-50, 54-62, 65-72 and 74-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 7, 9-22, 26, 28-44, 46-50, 54-62, 65-72 and 74-78 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bansleben et al. (U.S. 6,255,248) in view of Cahill et al. (U.S. 6,083,585).

See the Office action of Paper No. 11 at page 3 line 10 et seq. (the Office action of 3-13-02).

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Ban Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-3, 7, 9-22, 26, 28-44, 46-50, 54-62, 65-72 and 74-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,525,123. Although the conflicting claims are not identical, they are not patentably distinct from each other because choice of one species rather than another would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in the expectation that one species would work as well as another and in the expectation of adequate results absent any showing of surprising or unexpected results.

Applicants' arguments filed 2-10-03 have been fully considered but they are not deemed to be persuasive.

The pending claims are 1-4, 7-23, 26-44, 46-51, 54-62 and 65-78 as applicants correctly allege. Applicants are also correct that claims 4, 8, 23, 27, 51 and 73 are withdrawn from consideration.

Applicants argue that Bansleben require units derived from strained cycloalkenes such as cyclopentene. Applicants also argue that the inclusion of polymer units comprising an ethylenically unsaturated carbon carbon double bond is optional and therefore Ban Sleben teaches away from the oxygen scavenging polymers containing only units comprising an ethylenically unsaturated carbon carbon double bond as the scavenging moiety.

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While it may be so that Bansleben teaches away from oxygen scavenging polymers containing only units comprising an ethylenically unsaturated carbon carbon double bond as the scavenging moiety, applicants' claims are not so limited. Applicants may if they wish amend the claims to recite that the oxygen scavenging moieties of the oxygen scavenging ethylene/vinyl cyclohexene copolymer consist essentially of vinyl cyclohexene units if they wish. Such an amendment would be viewed as excluding substantial amounts of units such as cyclopentene units such as are present in the reference and would overcome the rejection relying upon Bansleben as primary reference.

Applicants argue that Bansleben's discussion of oxygen scavenging layers and oxygen barrier layers as separate layers suggest the failure by those authors to envision blends of oxygen scavenging layers and oxygen barrier layers as being useful in packaging articles. It is not clear however what applicants intend by blends of layers, but in any case patentees clearly disclose the production of packaging articles at column 4 lines 46-48. Applicants argue that Bansleben provided no data reporting oxygen permeability of films formed from oxygen barrier polymers alone much less films formed from blends of oxygen scavenging polymers and oxygen barrier polymers. However it is not clear what this has to do with patentability. Applicants

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argue that one of ordinary skill in the art would have no basis to expect that films formed from such blends would have reduced oxygen permeability relative to films formed from oxygen barrier layers alone. However, since oxygen scavenging polymers are capable of destroying oxygen, it would be reasonable for those skilled in the art to expect reduced oxygen permeability when using a combination of oxygen scavenging and oxygen barrier polymer. Arguably the Examiner may be incorrect about this but in any case a clear prima facie case of obviousness can be made for adding the specific diluent polymers of Bansleben to oxygen scavenging polymers since Bansleben specifically discloses that this may be done. Therefore burden is shifted to applicants to show unexpected results. With regard to such results, applicants point to the specification. However unexpected results must be with the closest prior art and not with other prior art, MPEP § 716. In the instant case, there are no embodiments shown in the instant specification in which comparative examples utilizing the specific vinyl cyclohexene polymers of patentees versus those of the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is before final (703) 872-9310 and after final (703) 8729311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cdc

April 18, 2003

Jeffrey Mullis
Primary Examiner
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A handwritten signature in dark ink, appearing to read 'Jeffrey Mullis', is written over the typed name and title.